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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,611	09/29/2003	William J. Boyle	ACS 63641 (3386X)	6361
24201	7590	06/07/2007		
FULWIDER PATTON LLP HOWARD HUGHES CENTER 6060 CENTER DRIVE, TENTH FLOOR LOS ANGELES, CA 90045			EXAMINER PRONE, CHRISTOPHER D	
			ART UNIT 3738	PAPER NUMBER
			MAIL DATE 06/07/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/675,611

Applicant(s)

BOYLE ET AL.

Examiner

Christopher D. Prone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 5,6 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-10 and 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date, _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/9/07 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-10 and 12-14 rejected under 35 U.S.C. 102(b) as being anticipated by (USPN 6,228,062) Howell et al.

Howell discloses the same invention as claimed being a torque device comprising a guidewire (24), a split seam sheath (36), handle (32) with a lumen (60) extending there through, a side-port (46) to remove the sheath from the guidewire, an extension arm (10) having an a tubular extension (shown near the reference character 58 in figure 5) and an opening for receiving both the guidewire and sheath.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7, and 15-20 are rejected under 35 U.S.C. 103 as being unpatentable over (FPD FR 2580504) Pieronne in view of (USPN 6,228,062) Howell et al and further in view of (USPN 6,616,680) Thielen.

Pieronne discloses the invention substantially as claimed being an embolic filtering system comprising an expandable filter frame (1), a filter element (11), and a split seam sheath (16). However, Pieronne does not disclose all the structural elements of the torque device or that the filter is self-expanding.

Howell teaches the use of a locking torque device comprising a guidewire (24), a split seam sheath (36), handle (32) with a lumen (60) extending there through, a funnel shaped side-port (46 shown in figure 5) to remove the sheath from the guidewire, a locking mechanism (comprising elements 50 and 52), an extension arm (10) having an a tubular extension (shown near the reference character 58 in figure 5) and an opening for receiving both the guidewire and sheath, and a member (34) for preventing kinking of the guidewire in the same field of endeavor for the purpose of providing the user with enhanced ability to lock and maneuver the sheath and guidewire.

Thielen teaches the use of a filter comprising nitinol for the purpose of providing a temperature sensitive self-expanding frame.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the end seal 19 of Pieronne with the torque member disclosed by Howell and to incorporate the self-expanding nitinol frame material in order to provide the operator better control the separation sheath during its separation from the guidewire and a frame with enhanced expansion ability.

Response to Arguments

Applicant's arguments filed 2/20/07 have been fully considered but they are not persuasive.

The applicant argues, that the guidewire of Howell as identified by the examiner, does not function as a guidewire. The examiner maintains his opinion that element 24 of Howell performs the functions of a guidewire by guiding the device to a desired operating site. Furthermore there is no structural limitation that would not allow element 24 of Howell from functioning as a guidewire in the examples given by the applicant.

The applicant further argues that the Howell device is not designed to split from proximal retraction of the sheath. However the examiner is adding the torque device of Howell to Pieronne at its proximal end (shown in figure 3 of Pieronne) to better control and guides the separation of the sheath. Pieronne is already splitting its sheath through proximal retraction. The combination simply gives the user better control of both the sheath and the guidewire. Therefore the device of Howell splits its sheath through proximal retraction.

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Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Prone whose telephone number is (571) 272-6085. The examiner can normally be reached on Monday Through Fri 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher D Prone
Examiner
Art Unit 3738


CDP


CORRINE McDERMOTT
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